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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,545	03/22/2001	Allen R. DeCotiis	PNX1P002	6466

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04/06/2006

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EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/815,545

Applicant(s)

DECOTIIS ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-14-05</u> . | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-20 have been examined.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-20 are rejected under 35 U.S.C. 101 because: the claimed invention is directed to non-statutory subject matter.

Claims 1, 8 and 15 are directed to calculating a score. However, the calculated score is not used in a subsequent step or by a structure to perform a task or function. Hence, Applicant's claimed method and system represent abstract ideas as each fails to produce a useful, concrete and tangible result (*State Street Bank & Trust Co. v. Signature Financial Group Inc.* (CA FC) 47 USPQ2d 1596 (7/23/1998)). Further, in claim 15 it is not clear whether or not the logic is stored on a computer. Therefore, claim 15 is also non-statutory as it is directed to computer code not stored on a computer readable medium (MPEP 2100-13, second column, first and second full paragraphs).

Claims 2-7, 9-14 and 16-20 are also rejected as each depends from either claim 1, 8 or 15.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites a system with a processor *for* implementing a series of logical steps, however, it is not clear to one of ordinary skill where the “logic” is stored (*In re Collier*, 158 USPQ 266 (CCPA 1968); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Claims 16-20 are also rejected as they depend from claim 15.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1, 4-8, 11-15, and 18-20 are rejected under 35

U.S.C. 102(e) as being clearly anticipated by Jacobi et al., U.S. Patent No. 6,317,722.

As per claims 1, 4-8, 11-15, and 18-20, Jacobi et al. teach a method for providing a model indicating a propensity of an individual to have a particular attitude, behavior or demographic comprising:

- identifying a plurality of users (figure 1; column 7, lines 45-64)
- retrieving first information on each of the individuals (figure 1; column 7, lines 45-64)
- conducting a survey to collect second information from each of the individuals (figure 1; column 8, lines 26-50)
- creating a model that defines a relationship between the first and second information (column 14, lines 46-55)
- calculating a score for each individual based on the first information, the second information and the model, wherein the score represents a propensity of the individual to have a particular attitude, behavior or demographic (column/line 14/31-16/19)
- first information from a list (figure 3)
- second information that includes information on a purchase intent (figure 1; column 8, lines 26-50)

- a model that sets forth a plurality of characteristics and a weight of each of the characteristics for calculating the score (column/line 14/56-15/55)
- an equation based on first information, second information and the model to generate a score (column/line 14/56-15/55)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 3, 9, 10, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobi et al., U.S. Patent No. 6,317,722 in view of Herz et al., U.S. Patent No. 5,754,938.

As per claims 2, 3, 9, 10, 16, and 17, Jacobi et al. teach a method for calculating a score that measures the propensity of the individual to have a particular attitude, behavior or demographic (column/line 14/31-16/24). However, Jacobi et al. do not specifically recite sorting individuals based on said score. Herz et al. teach a method for sorting individuals based on a score (column 20, lines 9-40; column 23, lines 40-53; column

41, lines 43-67; column 56, lines 9-24; column 60, lines 1-33). Herz et al. also teach enabling a user to control which third parties have access to said user's profile. Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Jacobi et al. and Herz et al. in order to refine the recommendation process ('722, abstract; '938, column 60, lines 1-32) by storing user attributes such as purchase history ('722, figure 1; '938, column 11, lines 10-33; column 20, lines 9-40) and directing recommendations based on additional criteria such as user sorting or clustering ('938, column 41, lines 43-67; column 56, lines 9-25; column 60, lines 1-33).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

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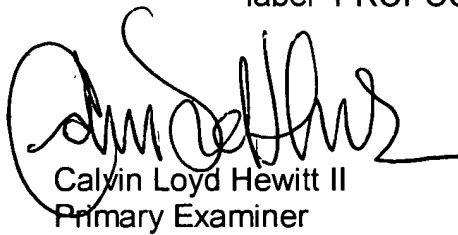
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for  
entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please  
label "PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II  
Primary Examiner

April 3, 2006